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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER	
ROANE, AARON F	

ART UNIT	PAPER NUMBER
3769	

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10/14/2010	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/727,144	SWANSON ET AL.	
	Examiner	Art Unit	
	AARON ROANE	3769	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *18 May 2010*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-22 and 38-59* is/are pending in the application.

4a) Of the above claim(s) *9,12,19,21,23,44 and 46* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-8,10,11,13-18,20,22,38-43,45 and 47-59* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *02 December 2003* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 05/18/2010 has been entered.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-8, 10, 11, 13-18, 20, 22, 38-43, 45, 47-52 and 56-59 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tetzlaff et al. (U.S. Patent 6,277,117) in view of Francischelli et al. (U.S. Patent 6,807,968) in further view of Maguire et al. (U.S. Patent 5,755,760).

Regarding claim 1-8, 10, 11, 13-18, 20, 22, 38-43, 45, 47-52 and 56-58, Tetzlaff et al. disclose an apparatus comprising a clamp including a first clamp member ("end effector" 22, see col. 3:33–62 and figures 1-8), a second clamp member ("end effector" 24, see col. 3:33–62 and figures 1-8), and movement apparatus (collectively 12, 14, 16, 18 and 25, see col. 3:33–62 and figures 1-8) that moves at least one of the first and second clamp members relative to the other of the first and second clamp members such that the surgical apparatus has an open state and a closed state; a first base member ("insulative substrate" 111, see col. 6:36 – col. 7:17 and figures 2-7) including a mating structure ("detents" 112) and defining a groove therein ("overmolded" portion of 111 forms a groove for receiving the first electrically conductive (coagulation) electrode, see col. 6:36–49 and figures 5-7), the mating structure being configured to removably securing the first base member to the first clamp member; a second base member ("insulative substrate" 121, see col. 6:36 – col. 7:17 and figures 2-7) including a mating structure ("detents" 122) and defining a groove therein ("overmolded" portion of 121 forms a groove for receiving the second electrically conductive (coagulation) electrode, see col. 6:36–49 and figures 5-7), the mating structure being configured to removably securing the second base member to the second clamp member; a first coagulation element, in the form of a coagulation electrode ("conductive seal" 116 of "electrode" 110, see col. 6:66 – col. 7:38 and figures 2-7) carried by the first base member; and a second coagulation element, in the form of a coagulation electrode ("conductive seal" 126 of "electrode" 120, see col. 6:36 – col. 7:38 and figures 2-7) carried by the second base member; and a source of coagulation energy ("electrosurgical generator", see col. 6:13-34 and figures 1

and 3) operatively connected to the first and second coagulation electrodes. Tetzlaff et al. fail to disclose a first and second support members, the first and second grooves formed within the first and second base members being configured to receive the first and second support member respectively, and that the first and second support members carry the first and second coagulation members and first and second stimulation elements respectively. Tetzlaff et al. fail to disclose a source of stimulation energy. Additionally, Tetzlaff et al. fail to a distal end of each stimulation element is disposed distal to a distal end of each support member. Francischelli et al. disclose an ablating/coagulating forceps apparatus and teach providing the device with an insulative base member (27 or analogous counterparts in other embodiments) defining a groove therein for engaging a support member (31A or analogous counterparts in other embodiments), the groove formed within the base member being configured to receive the support member; a coagulation element or means for transmitting coagulation energy, in the form of an electrode (30A or analogous counterparts in other embodiments) carried by the support member in order to provide the clamping forceps device with both electrosurgical energy and fluid delivery to treat cardiac tissue suffering from arrhythmias, see col. 2:47 - col. 4:59 and figures 1-5B. It should be noted that Francischelli et al. disclose first and second clamping members having corresponding first and second base members; first and second support members that carry first and second coagulation elements/electrodes respectively. Additionally, it should be noted that the structural configuration of the support member is very suggestive of a catheter. Maguire et al. disclose a catheter (i.e. support member) and teach providing the catheter (i.e. support member) with both

ablation/coagulation elements/electrodes ("electrodes" 12 and 16, see col. 3:43 - col. 4:14 and figure 3) and stimulation elements/electrodes (for example "mapping" electrode 20, see col. 3:43 - col. 4:14 and figure 3) wherein the stimulation element/electrode ("electrode" 20) is disposed distal to the distal end of the support member (the catheter) in order to treat cardiac arrhythmias by creating lesions (coagulated tissue), see col. 2:6-16, col. 3:43 - col. 4:14 and figure 3. It should be noted, the teachings of Francischelli et al. and Maguire et al. do not destroy any functionality of the Tetzlaff et al. patent. Therefore at the time of the invention it would have been obvious to one of ordinary skill in the art to modify the invention of Tetzlaff et al., as taught by Francischelli et al., to provide the device with support member that carries the coagulation electrode, wherein the support member is directly engaging the insulative base member, in order to provide device with both electrosurgical energy and fluid delivery to treat cardiac tissue suffering from arrhythmias, and as further taught by Maguire et al., to provide the device with a support member that carries both ablation/coagulation elements/electrodes and stimulation elements/electrodes wherein one stimulation element/electrode is disposed distal to the distal end of the support member (the catheter) in order to treat cardiac arrhythmias by creating lesions (coagulated tissue). Finally and although the references are silent as to a stimulation source, it is extremely well known to one of ordinary skill in the art at the time of the invention that 1) multi-function electrosurgical generator providing both ablative/coagulative and stimulative/mapping pulses/energy or 2) two separate electrosurgical generators for providing ablative/coagulative and

stimulative/mapping pulses/energy in order to treat tissue by creating lesions/seals at the desired target tissue site.

Regarding claim 59, Tetzlaff et al. in view of Francischelli et al. in further view of Maguire et al. disclose the claimed invention. Most specifically Tetzlaff et al. disclose the overmolding of the insulative base members that clearly meets the recited structural and/or functional limitation.

Claims 53 and 54 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tetzlaff et al. (U.S. Patent 6,277,117) in view of Francischelli et al. (U.S. Patent 6,807,968) in further view of Maguire et al. (U.S. Patent 5,755,760) as applied to claim 1 above.

Regarding claims 53 and 54, Tetzlaff et al. in view of Francischelli et al. in further view of Maguire et al. disclose the claimed invention except for explicitly reciting the base member is formed from a polymer in the form of polyurethane. It would have been obvious to one having ordinary skill in the art at the time the invention was made to a polymer for the base and/or a base made from polyurethane or any other insulative material, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

Claim 55 is rejected under 35 U.S.C. 103(a) as being unpatentable over Tetzlaff et al. (U.S. Patent 6,277,117) in view of Francischelli et al. (U.S. Patent 6,807,968) in further view of Maguire et al. (U.S. Patent 5,755,760) as applied to claim 1 above, and further in view of Eggers et al. (U.S. Patent 6,032,674)

Regarding claim 55, Tetzlaff et al. in view of Francischelli et al. in further view of Maguire et al. disclose the claimed invention except for explicitly reciting an adhesive that holds the coagulation element and the support member in place. It is extremely well known in the art to secure electrodes to insulators or insulating members by using an adhesive to securely fix them together. As an example, Eggers et al. disclose electrosurgical system having an elongate probe (10) and teach "sealing material 402 is used to seal annular gaps between hollow tube 400 and electrode terminal 58 and to adhesively join electrode terminal 58 to hollow tube 400" in order to fix the electrode(s) to the insulative tube and provide structural integrity, see col. 15:29-col. 16:67 and figures 1-2E. Therefore at the time of the invention it would have been obvious to one of ordinary skill in the art to modify the invention of Tetzlaff et al. in view of Francischelli et al. in further view of Maguire et al., as taught by Eggers et al., to adhesively bond the electrode to the tubular insulating member in the form of PTFE (insulative) tubular member in order to fixedly secure them together and provide structural integrity.

Response to Amendment

The declaration under 37 CFR 1.132 filed 05/18/2010 is sufficient to overcome the rejection of claims 1-8, 10, 11, 13-18, 20, 22, 38-43, 45 and 47-59 based upon obviousness 103 rejections using Hooven as the primary reference, wherein the arguments are directed to the rearrangement of the electrodes 168 and 172/174.

However, new grounds of rejection have been provided.

Response to Arguments

Applicant's arguments, see pages 1-3, filed 05/18/2010, with respect to the rejection(s) of claim(s) 1-8, 10, 11, 13-18, 20, 22, 38-43, 45, 47-59 under 103 have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of the combination of Tetzlaff et al. in view of Francischelli et al. in further view of Maguire et al., wherein Maguire et al. is the newly used reference, Hooven has been removed from the rejections and Tetzlaff et al. serves as the new primary reference.

The Applicant is invited to request an interview to discuss suggestions to find an acceptable conclusion of the prosecution for all parties.

Due to the RCE, this action is made non final.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to AARON ROANE whose telephone number is (571)272-4771. The examiner can normally be reached on Monday-Thursday 8:30AM-7PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Henry Johnson can be reached on (571) 272-4768. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Aaron Roane/
Examiner, Art Unit 3769